

Remarks

Claims 13, 14 and 38-47 have been canceled pursuant to the restriction requirement made final in the Office Action. Applicants reserve the right to file a divisional application covering the non-elected subject matter. Claims 48 and 49 also have been canceled without prejudice to the subject matter contained therein. Claims 1-12 and 15-37 remain pending in the application.

According to the Office Action, no benefit of earlier filing dates can be granted due to a chain of pendency issue. Applicants respectfully submit herewith a supplemental declaration under 37 C.F.R. § 1.67. The declaration previously submitted contained a typographical error in the identification of one of the prior applications from which this application claims priority. The previously submitted declaration indicates that priority is claimed from U.S.S.N. 09/329,516. The correct application number is U.S.S.N. 09/392,516, as indicated on the Utility Patent Application Transmittal Letter filed April 27, 2000, and the filing receipt issued for the present application.

Additionally, the supplemental declaration claims priority to two applications not previously listed on the declaration. This claim meets the requirements of 37 C.F.R. § 1.78. The specification has been amended as required by 37 C.F.R. § 1.78(2)(i) to reflect the claim of priority now presented. Since the present application was filed April 27, 2000, the time periods of 37 C.F.R. § 1.78 (2)(ii) do not apply, as provided in 37 C.F.R. § 1.78(2)(ii)(B). Thus, this claim for priority is timely presented.

Claims 1-12 and 15-37 were rejected under 35 U.S.C. § 102(a) or 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over WO 98/11853. Applicants respectfully traverse this rejection.

WO 98/11853 was published March 26, 1998, and claims priority from U.S.S.N. 08/715,911, filed September 19, 1996. Applicants claim priority to U.S.S.N. 09/164,293, filed October 1, 1998, which is a continuation of U.S.S.N. 08/715,911, filed September 19, 1996. Thus, WO 98/11853 and the present application both claim priority to the same application. The PCT publication has substantially the same disclosure as the parent application, 08/715,911. To the extent the claims in the present application are supported in the parent application, 08/715,911, Applicants may rely on the filing date thereof since any claims which are fully supported under 35 U.S.C. § 112 by the earlier parent application have the effective filing date of that earlier parent application. *MPEP* § 716.02.

Where there is support for the claimed subject matter in a parent application, Applicants are entitled to rely on the filing date of the parent application. Applicants believe such support may be found in the parent application to which priority is now claimed. Support for this position may be found in the rejections of the pending Office Action. The Office Action lists the elements of the present claims which are found in WO 98/11853, and indicates that claims 1-12 and 15-37 are "clearly anticipated" or at the very least rendered obvious by WO 98/11853. Since the claims were found anticipated under 35 U.S.C. § 102(b), the Office Action substantiates the view that the PCT publication provides support for the present claims.¹

¹See, *Paperless Accounting, Inc. v. Bay Area Rapid Transit*, 231 USPQ 649, 653 (Fed. Cir. 1986), cert. denied, 480 U.S. 933 (1987) ("Thus, if any claim of the '300 patent is determined to be limited to the filing date of the '529 c-i-p on the basis that the disclosure of the '196 parent is insufficient to support such claim, a corresponding foreign publication that is substantially the same is also insufficient to anticipate such claim under § 102(b)).

Also see, *Chester v. Miller*, 15 USPQ2d 1333, 1336 (Fed. Cir. 1990) ("Although in some circumstances we could agree with Chester's implicit argument that a prima facie case of anticipation could not be established if [the judge] concluded both that the subject matter claimed in a CIP application is not *enabled* by a parent application and that the claims are anticipated by the parent which has



Since the filing date of the parent application, 08/715,911, predates the PCT publication date of WO 98/11853, Applicants respectfully request that this rejection be withdrawn.

Claims 1 and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of WO 98/11853 and Brosnahan, U.S. Patent No. 5,766,253. Claims 1 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of WO 98/11853 and Medline Abstract 85076876. Claim 1 is discussed above. Claims 48 and 49 have been canceled without prejudice. Therefore, Applicants respectfully request that these rejections be withdrawn.

Claims 1, 6, 7, 9 and 48 were rejected under 35 U.S.C. § 102(a) or (e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Boyan et al., U.S. Patent No. 5,977,204. Applicants respectfully traverse this rejection.

The Boyan patent issued November 2, 1999, on an application filed April 11, 1997. The present application claims priority to an application filed September 19, 1996. In view of the above discussion, Applicants may rely on the claim for priority, removing the Boyan patent as prior art against claims 1, 6, 7 and 9. In view thereof, Applicants respectfully request that this rejection be withdrawn.

Applicants note with appreciation the initialed PTO-1449 included with the Official Action. However, Applicants filed an Information Disclosure Statement February 13, 2001, for which an initialed PTO-1449 has not been received. It is

issued as a patent, we cannot agree that this is always so. For example, a CIP's claim for a genus might not be enabled by a parent's disclosure, but that parent may enable a species that anticipates the CIP's claim for a genus.")

respectfully requested that an Examiner initialed copy of the PTO-1449 submitted with that Information Disclosure Statement be returned to the undersigned.

Applicants believe all matters raised in the above referenced Office Action have been addressed and that the application is now in condition for allowance. If the Examiner has any questions concerning this Application or this Response, the Examiner is invited to contact the undersigned.

Respectfully submitted,
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